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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/535,306

02/17/2006

Jean Beguinot

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EXAMINER

YEE, DEBORAH

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

08/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/535,306	<b>Applicant(s)</b> BEGUINOT ET AL.	
	<b>Examiner</b> Deborah Yee	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-13,15-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) 6-13,15-17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 6 to 13, 15 to 17 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Response to Arguments***

2. Applicant's arguments and amendment filed June 9, 2009, with respect to the rejection(s) of claim(s) 1 to 3 and 5 under 35 USC 103(a) as being unpatentable over US Patent 4,437,903 ("Furukawa") or Japanese patent 2000-355735 ("JP-735") have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration and updated search, a new ground(s) of rejection is made.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over European patent 0725156 ("EP-156") cited by Applicant in IDS dated May 18, 2005.

5. EP-156 in claims 1 to 6 on pages 8 and 9 discloses a steel composition with constituents whose wt% ranges overlap those recited by the claims; and such overlap

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establishes a prima facie case of obviousness because it would be obvious for one skilled in the art to select the claimed alloy wt% ranges over the broader disclosure of the prior art because the prior art teaches same utility to make weldable steel component and the same microstructure comprising martensite and/or bainite with 5 to 30 vol.% residual austenite, see MPEP 2144.05.

6. Even though the equations recited by the claims are not taught by prior art, such difference would not be a patentable merit because it has been well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357,553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 630 O.G. 685, 1949 C.D. 77 and *In re Pilling*, 403 O.G. 513, 44F (2) 878, 1931 C.D. 75. Also in the absence of evidence to the contrary, the selection of the proportion of elements would appear to require no more than routine investigation by those of ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, since the concentration of each element in prior art overlaps the claimed concentration of the corresponding element, then the claimed equations would have been expected to be met in prior art.

7. More specifically, example F on lines 15 to 20 on page 7 closely meets the claimed composition and claimed equations. Although example F does not disclose nitrogen, it would obviously be present as an inevitable impurity close to zero and therefore would satisfy Applicant's lower N limit of  $>0$ .

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8. Claims 1 to 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over European patent 0974677 ("EP-677") cited by Applicant in IDS dated May 18, 2005.

9. EP-677 in item (5) on lines 40 to 47 on page 4 discloses a steel composition with constituents whose wt% ranges overlap those recited by the claims; and such overlap establishes a prima facie case of obviousness because it would be obvious for one skilled in the art to select the claimed alloy wt% ranges over the broader disclosure of the prior art because the prior art teaches structural steel having similar microstructure comprising bainite with retained austenite, see MPEP 2144.05.

10. Even though the equations recited by the claims are not taught by prior art, such difference would not be a patentable merit because it has been well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357,553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 630 O.G. 685, 1949 C.D. 77 and *In re Pilling*, 403 O.G. 513, 44F (2) 878, 1931 C.D. 75. Also in the absence of evidence to the contrary, the selection of the proportion of elements would appear to require no more than routine investigation by those of ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, since the concentration of each element in prior art overlaps the claimed concentration of the corresponding element, then the claimed equations would have been expected to be met in prior art.

11. More specifically, example 27 in table 5 on page 24 appear to closely meet the claimed composition and equations; and in table 7 on page 28 exhibits a bainitic

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microstructure with 9% retained austenite. Although prior art microstructure contains ferrite, such would not be excluded by inventive claim since it is open-ended with the recitation "comprises".

12. For the foregoing reasons, claims would not patentably distinguish over prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on monday-friday 6:00 am-2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Yee/  
Primary Examiner  
Art Unit 1793

/DY/

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